

REMARKS

Claims 6-16 and 25-42 were previously canceled without prejudice. Claims 1-5 and 17-24 remain in the application. In view of the following remarks, Applicant respectfully requests that the rejections be withdrawn and that the application be forwarded on to issuance.

§ 101 Rejections

Claims 17-21, 25-29 and 32-40 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant previously canceled claims 6-16 and 25-42 in an amendment filed on February 22, 2005. It appears that the present Office Action was mailed on February 23, 2005. Thus, it appears that Applicant's filed amendment may not have been part of the file when the Examiner issued the Office Action.

Applicant will proceed in addressing the Office's rejections only with regard to the claims that remain in the application.

Claim 17 has been amended to recite that the method is a "computer-implemented" method. Accordingly, Applicant traverses the § 101 rejection.

§ 103 Rejections

Claims 1-4, 17-20 and 22-23 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,768,523 to Schmidt et al. (hereinafter "Schmidt") in view of U.S. Patent No. 6,088, 018 to DeLeeuw et al. (hereinafter "DeLeeuw").

1 Claims 5, 21 and 24 stand rejected under 35 U.S.C. § 103(a) as being
2 obvious over Schmidt and DeLeeuw in view of a publication entitled "Computer
3 Graphics Workshop '97 Lecture Notes" (hereinafter "Computer Graphics").
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5 **The Claim Rejections**

6 **Claim 1 recites a system comprising:**

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8 • an event prediction module operably associated with multiple media
9 content samples that are to be rendered for a user, the module being
10 configured to:
11 ○ receive event notification requests from an application pertaining
12 to events associated with the media content samples; and
13 ○ predict rendition times associated with the individual events.

14 In making out the rejection of this claim, the Office argues that Schmidt
15 discloses all of the subject matter of this claim except for media content samples
16 that are to be rendered for a user and events associated with the media content
17 sample. For this subject matter, the Office then relies on DeLeeuw and argues that
18 it discloses the subject matter missing from Schmidt and that the subject matter of
19 this claim is obvious in view of the two references. As a motivation to combine
20 the two references, the Office argues that the motivation would exist "because
21 DeLeeuw's media content samples that are to be rendered for a user, and events
22 associated with the media content samples would control and process [a] stream of
23 time stamped multimedia data signals more effectively by using modular software
24 components called filters." See, Office Action, Page 3-4.
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The Office has failed to establish a *prima facie* case of obviousness for at
least two reasons. First, the combination of references does not teach all of the

1 claim features appearing in this claim. Second, the Office's stated motivation to
2 combine the references, to the extent it pertains to the specifically recited subject
3 matter—to work more effectively—is lacking in the particularity that is required
4 to make out a *prima facie* case of obviousness.

5 Addressing the first reason the Office failed to establish a *prima facie* case
6 of obviousness, consider the following.

7 To establish a *prima facie* case of obviousness, three basic criteria *must* be
8 met. First, there must be some suggestion or motivation, either in the references
9 themselves or in the knowledge generally available to one of ordinary skill in the
10 art, to modify the reference or to combine reference teachings. *In re Jones*, 958
11 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5
12 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation
13 of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.
14 1986). Finally, the prior art reference (or references when combined) must teach
15 or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580
16 (CCPA 1974).

17 Hence, when patentability turns on the question of obviousness, the search
18 for and analysis of the prior art includes evidence relevant to the finding of
19 whether there is a teaching, motivation, or suggestion to select and combine the
20 references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin*
21 *Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)
22 ("the central question is whether there is reason to combine [the] references," a
23 question of fact drawing on the Graham factors).

24 "The factual inquiry whether to combine references must be thorough and
25 searching." *Id.* It must be based on objective evidence of record. This precedent

1 has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g.,
 2 *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-
 3 25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion,
 4 teaching, or motivation to combine the prior art references is an 'essential
 5 component of an obviousness holding'") (quoting *C.R. Bard, Inc. v. M3 Systems,*
 6 *Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re*
 7 *Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our
 8 case law makes clear that the best defense against the subtle but powerful
 9 attraction of a hindsight-based obviousness analysis is rigorous application of the
 10 requirement for a showing of the teaching or motivation to combine prior art
 11 references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed.
 12 Cir. 1998) (there must be some motivation, suggestion, or teaching of the
 13 desirability of making the specific combination that was made by the applicant); *In*
 14 *re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings
 15 of references can be combined only if there is some suggestion or incentive to do
 16 so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*,
 17 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

18 The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217
 19 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings
 20 must be made as to the reason the skilled artisan, with no knowledge of the
 21 claimed invention, would have selected these components for combination in the
 22 manner claimed").

23 In this case, the Office argues that Schmidt discloses an event prediction
 24 module as recited in this claim, and one which predicts rendition times associated
 25 with individual events, as recited in this claim. In support of this contention, the

1 Office cites specifically to Schmidt's event management daemon (column 4, lines
2 64-67), the event generation module (column 6, lines 65-67 to column 7, lines 5-
3 10) and to column 7 lines 3-11 for the notion that Schmidt discloses predicting
4 rendition times.

5 Applicant respectfully disagrees. Applicant can find no disclosure, hint or
6 suggestion in the excerpts cited by the Office that even alludes to an event
7 prediction module that is configured to *predict* rendition times associated with
8 individual events. The excerpt of Schmidt that is cited by the Office as disclosing
9 this notion (column 7, lines 3-11) reads as follows:

10 ...receive information regarding *predicates* which characterize
11 events for particular resources from the predicate database 64. The event
12 generation module may thus be provided with logic for comparing resource
13 states and predicates to determine the occurrence of events. The event
14 generation module 58 may be provided with logic such that its operation is
15 invoked upon the queuing of state data from the resource state observation
16 module 52. The event generation module may provide notice of events to
17 an event notification module 60.

18 Earlier on in Schmidt, the predicate database is described as follows, "[t]he
19 predicate database may contain the states which characterize events occurring in
20 resources having resource state indicators which are local to the event
21 management daemon." See, e.g. column 6, lines 39-42. A few lines above,
22 Schmidt states as follows, "[t]he state which characterizes an event may also be
23 referred to as a predicate, and may be stated as an absolute value, or as a threshold
24 value, or as the occurrence of a specified change in state." See, e.g. column 6,
25 lines 30-35.

1 Nowhere do these excerpts disclose or even suggest an event prediction
2 module that is configured to predict rendition times associated with individual
3 events. Accordingly, for at least this reason, the Office has failed to establish a
4 *prima facie* case of obviousness.

5 Addressing now the second reason the Office failed to establish a *prima*
6 *facie* case of obviousness, consider the following.

7 As a motivation to combine these references, the Office essentially argues
8 that doing so would provide a more effective system. Applicant notes that in
9 phrasing the motivation, the Office uses terminology that simply does not appear
10 in the claim. Applicant wishes for the record to reflect that on this ground alone,
11 the Office has failed to establish a *prima facie* case of obviousness. Applicant
12 does not agree and respectfully submits that the claim contains no such subject
13 matter and hence, the Office motivation is inappropriate and misplaced.

14 Assuming *arguendo* that the Office had utilized this claim's terminology in
15 making out the rejection, the Office has still failed to establish a *prima facie* case
16 of obviousness because the Office's stated motivation – to make a more effective
17 system – is lacking in the particularity that is required to make out a *prima facie*
18 case of obviousness. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d
19 1313, 1317 (Fed. Cir. 2000) ("*particular findings* must be made as to the reason
20 the skilled artisan, with no knowledge of the claimed invention, would have
21 selected these components for combination in the manner claimed") (emphasis
22 added). The Office's stated motivation could conceivably be used to make any
23 number of modifications to Schmidt's subject matter. Hence, for this additional
24 reason, the Office has failed to establish a *prima facie* case of obviousness.

1 Claims 2-5 depend from claim 1 and are allowable as depending from an
2 allowable base claim. In addition, given the Office's failure to make out a *prima*
3 *facie* case of obviousness with regard to claim 1, the Office's reliance on
4 Computer Graphics in making out the rejection of claim 5 is not seen to add
5 anything of significance.

6 Claim 17 recites a computer-implemented method comprising:

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- 8 • receiving an event notification request from an application, the event
9 notification request requesting a notification pertaining to events
associated with one or more media content samples that are to be
rendered; and
- 10 • predicting rendition times associated with the individual events.

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12 In making out the rejection of this claim, the Office argues that this claim is
13 rejected in a manner similar to claim 1. Applicant notes that this claim does not
14 recite an event prediction module, as does claim 1. Rather, this claim recites, in
15 pertinent part, "predicting rendition times associated with the individual events".
16 As Schmidt neither discloses nor suggests any such subject matter, the Office has
17 failed to establish a *prima facie* case of obviousness. In addition, to the extent the
18 Office would apply the same motivation to combine Schmidt and DeLeeuw *with*
19 *regard to the specifically-recited subject matter of this claim*, the Office would
20 not be able to establish a *prima facie* case of obviousness.

21 Accordingly, for all of these reasons, this claim is allowable.

22 Claims 18-21 depend from claim 17 and are allowable as depending from
23 an allowable base claim. In addition, given the Office's failure to make out a
24 *prima facie* case of obviousness with regard to claim 17, the Office's reliance on
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1 Computer Graphics in making out the rejection of claim 21 is not seen to add
2 anything of significance.

3 **Claim 22** recites one or more computer-readable media having computer-
4 readable instructions thereon which, when executed by one or more processors,
5 cause the one or more processors to:

- 6 • receive an event notification request from an application, the event
7 notification request requesting a notification pertaining to events
8 associated with one or more media content samples that are to be
rendered;
- 9 • predict rendition times associated with the individual events; and
- 10 • send at least one event notification to the application responsive to
an associated event having been predicted to occur at a particular
rendition time.

12 In making out the rejection of this claim, the Office argues that this claim is
13 rejected in a manner similar to claim 1. Applicant notes that this claim does not
14 recite an event prediction module, as does claim 1. Rather, this claim recites, in
15 pertinent part, “predict rendition times associated with the individual events”. As
16 Schmidt neither discloses nor suggests any such subject matter, the Office has
17 failed to establish a *prima facie* case of obviousness. In addition, to the extent the
18 Office would apply the same motivation to combine Schmidt and DeLeeuw *with*
19 *regard to the specifically-recited subject matter of this claim*, the Office would
20 not be able to establish a *prima facie* case of obviousness.
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22 Accordingly, for all of these reasons, this claim is allowable.

23 **Claims 23-24** depend from claim 22 and are allowable as depending from
24 an allowable base claim. In addition, given the Office’s failure to make out a
25 *prima facie* case of obviousness with regard to claim 24, the Office’s reliance on

1 Computer Graphics in making out the rejection of claim 24 is not seen to add
2 anything of significance.

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Conclusion

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Applicant submits that all of the claims are in condition for allowance and respectfully requests that the Office pass the application along to issuance. If the Office's next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of scheduling an interview.

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Respectfully Submitted,

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By:


Lance R. Sadler
Reg. No. 38,605
(509) 324-9256, ext. 226

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